

**REMARKS/ARGUMENTS**

Claims 1-59 are pending in this application. Claims 1, 5, 11, 18, 31-32, 46 and 54 are amended herein. Applicant respectfully requests consideration and examination of pending claims 1-59.

I. **Specification and Claim Objections Based on Informalities**

Applicant acknowledges with appreciation that the Examiner has provided a clear recommendation for obviating each respective objection.

The Examiner has objected to the disclosure, stating that, on page 14, line 9, the term "client" should be inserted between the terms "the" and "plays".  
Applicant has amended the specification accordingly.

The Examiner has objected to claim 5, stating that the term "said" should be inserted between the terms "wherein" and "annotator" in line 1. Applicant has amended claim 5 accordingly.

The Examiner has objected to claim 11, stating that the term "device" should be inserted between the terms "thin-client" and "comprises" in line 1.  
Applicant has amended claim 11 accordingly.

The Examiner has objected to claim 31, stating that "said client" is not previously mentioned in the claims, and suggesting that the objection may be

obviated by amending the claim to depend from claim 30. Accordingly, Applicant has amended claim 31 to depend from claim 30.

The Examiner has objected to claim 54, stating that the term "step" should be inserted after the term "converting" in line 2 so that the claim reads more clearly. Applicant has amended claim 54 to recite that "a document processing engine converts said text elements to said second set of audio elements."

Applicant submits that claim 54 reads more clearly as amended.

II. Rejection of Claims Under 35 U.S.C. §102(e)

The Examiner has rejected claims 1, 2, 5-20, 22-26, 28, 29, 32-34, 36-40, 42, 43, 46-48, 50-54, 56 and 57 under 35 U.S.C. §102(e) as being anticipated by Groner (U.S. Patent No. 6,507,643). Applicant respectfully disagrees. Applicant submits that independent claims 1, 7, 18, 32 and 46, as well as their respective dependent claims, are allowable over the cited reference for at least the reasons discussed below.

A. Independent Claim 1

With respect to independent claim 1, the Examiner states:

Groner discloses an apparatus for annotating a document (see Figures 1-11; see Column 1, Line 1 through Column 24, Line 24), comprising:

- a processor (72, Figure 3);
- memory coupled to said processor (82, Figure 3), said memory comprising at least one text document (118 and 120, Figure 3);
- a document processing engine configured to obtain said at least one text document from said memory and convert at least a portion of said at least one text document to at least one audio file (see Column 1, Line 1 through Column 24, Line 24 – the messaging system includes a “document processing engine configured to obtain said at least one text document from said memory and convert at least a portion of said at least one text document to at least one audio file” in that the dialog manager obtains the text message and invokes the text-to-speech conversion process to recite the text message to the caller);
- an audio output device configured to play said at least one audio file to a first user (see Column 1, Line 1 through Column 24, Line 24 – the messaging system includes an “audio output device configured to play said at least one audio file to a first user” in that the dialog manager obtains

the text message and invokes the text-to-speech conversion process to recite the text message to the caller);

- an audio input device configured to obtain at least one verbalized comment from said user about said at least one audio file wherein said at least one verbalized comment is stored as an audio comment file (see Column 1, Line 1 through Column 24, Line 24 – the messaging system includes an “audio input device configured to obtain at least one verbalized comment from said user about said at least one audio file wherein said at least one verbalized comment is stored as an audio comment file” in that the dialog manager enables the caller to play the audio file of the voice message and to verbally replace words in the message);
- an annotator, said annotator configured to associate said audio comment file with a location in said text document that corresponds to said audio file playing when said first user provided said at least one comment (see Column 1, Line 1 through Column 24, Line 24 – the messaging system includes an “annotator configured to associate said audio comment file with a location in said text document that corresponds to said audio file playing when said first user provided said at least one comment” in that the dialog manager inserts the caller’s verbal edits into the appropriate parts of the text message where the verbal edits are inserted into the audio file of the voice message).

Applicant respectfully disagrees. Applicant submits that Groner fails to anticipate, teach or suggest the embodiment of the invention claimed in

independent claim 1 for at least the following reasons. Groner does not anticipate, teach or suggest an audio input device configured to: (1) obtain at least one verbalized comment about said at least one audio file; and (2) store said at least one verbalized comment as an audio comment file apart from said at least one audio file. Also, Groner does not anticipate, teach or suggest (3) an annotator configured to associate an audio comment file, which comprises at least one verbalized comment about said at least one audio file, with a location in said text document. Each of these distinctions is discussed in further detail below.

1. Groner does not anticipate, teach or suggest an audio input device configured to obtain at least one verbalized comment about said at least one audio file. Groner is a voicemail system designed to allow a sender to send a voice mail message as an emailed text message. Groner provides an editing mechanism whereby a sender may review his own message prior to sending, and replace words in that message. Applicant submits that this is a direct editing feature consistent with a voicemail system. However, as a voicemail system, Groner has no motivation and no supporting disclosure for obtaining "comments about" an audio file, which, in the context of Groner, would correspond to the sender's own message. In short, the sender is not making a comment; he is directly modifying the audio and text message files. This distinction between

obtaining a comment about a file and modifying the contents of a file is highlighted by the following distinction, i.e., that the comment is stored separately from the audio file.

2. Groner does not anticipate, teach or suggest an audio input device configured to store said at least one verbalized comment as an audio comment file apart from said at least one audio file. Groner permits a sender to edit the contents of his message, e.g., by specifying a specific number of words to be replaced by newly dictated words. Groner specifically states that editing creates a modified voice message 118 and a modified text message 110 (see col. 14, line 56), where the modified text message is merely a text version of the modified voice message. The previous versions of the voice message and the text message are replaced by the modified versions. Thus, the only files in Groner are the voice and text files of the same content.

In contrast to Groner, the embodiment of claim 1 (as amended) comprises an audio input device configured to store said at least one verbalized comment as an audio comment file “apart from said at least one audio file.” By replacing the prior versions of the voice and text files, Groner teaches away from any capability of distinguishing between a verbalized comment and a separate audio file. Again, this failure to teach, let alone anticipate, storing a comment

separately derives from the fact that Groner is merely a voicemail to email conversion system, and annotation capability is beyond the scope of Groner.

3. Because annotation is beyond the scope of Groner, Groner does not anticipate, teach or suggest an annotator configured to associate an audio comment file, which comprises at least one verbalized comment about said at least one audio file, with a location in said text document. As stated above, Groner does not keep a separate comment file, because Groner is only concerned with inserting into the current voice/text message or replacing all or part of the current voice/text message. Regardless, Groner does not teach or suggest associating any file, let alone an audio comment file, with a location in the text message (118).

For at least the foregoing reasons, Applicant submits that independent claim 1 is allowable over the cited reference. Further, claims 2-6, being dependent upon allowable base claim 1, are also allowable for at least the foregoing reasons.

B. Independent Claim 7

With respect to independent claim 7, the Examiner states:

Groner discloses an apparatus for annotating a document (see Figures 1-11; see Column 1, Line 1 through Column 24, Line 24), comprising:

- a server having a text-to-speech engine configured to obtain at least one text document from memory and convert at least a portion of said at least one text document to at least one audio file (as indicated in the above rejection for Claim 1, the messaging system discloses this limitation);
- a thin-client device configured to obtain said at least one audio file from said server (the messaging system discloses a “thin-client device configured to obtain said at least one audio file from said server” in that it includes a telephone);
- an audio output device configured to play said at least one audio file to a first user, wherein said audio output device is associated with said thin-client (as indicated in the above rejection for Claim 1, the messaging system discloses this limitation);
- said thin-client device having an audio input element configured to obtain at least one verbalized comment from said user about said at least one audio file, wherein said at least one verbalized comment is transmitted to said server and stored as an audio comment file on said server (the messaging system discloses a “thin-client device having an audio input element configured to obtain at least one

verbalized comment from said user about said at least one audio file, wherein said at least one verbalized comment is transmitted to said server and stored as an audio comment file on said server" in that it includes a telephone);

- said server having an annotator, said annotator configured to associate said audio comment file with a location in said text document that corresponds to said audio file playing when said first user provided said at least one comment (as indicated in the above rejection for Claim 1, the messaging system discloses this limitation).

Applicant respectfully disagrees. Applicant submits that Groner fails to anticipate, teach or suggest the embodiment of the invention claimed in independent claim 7 for at least the following reasons. As addressed above with respect to the embodiment of claim 1, Groner does not anticipate, teach or suggest an audio input device configured to: (1) obtain at least one verbalized comment about said at least one audio file; and (2) store said at least one verbalized comment as an audio comment file. Similarly, Groner does not anticipate, teach or suggest (3) a server having an annotator configured to associate said audio comment file with a location in said text document.

Applicant directs the Examiner to Applicant's arguments in sections (A)(1)-(A)(3) above for more detailed discussion of these distinctions.

For at least the foregoing reasons, Applicant submits that independent claim 7 is allowable over the cited reference. Further, claims 8-17, being dependent upon allowable base claim 7, are also allowable for at least the foregoing reasons.

C. Independent Claim 18

With respect to independent claim 18, the Examiner states:

Groner discloses a method for annotating a document (see Figures 1-11; see Column 1, Line 1 through Column 24, Line 24), comprising:

- obtaining a document from a memory medium via an interconnection path configured to access said document (as indicated in the above rejections for claims 7 and 8, the messaging system discloses this limitation);
- converting said document to audio elements (as indicated in the above rejection for Claim 7, the messaging system discloses this limitation);
- presenting an audible playback of said audio elements to a user when said user indicates a desire to hear said document (as indicated in the above rejection for Claim 7, the messaging system discloses this limitation);
- obtaining verbalized comments from said user via an audio input mechanism upon receipt of an annotation start mark during said audible playback (as indicated in the above rejections for Claims 7 and 15, the messaging system discloses this limitation);

- associating said verbalized comments with a location in said document corresponding with the occurrence of said annotation start mark during said audible playback (as indicated in the above rejection for Claim 7, the messaging system discloses this limitation).

Applicant respectfully disagrees. Applicant submits that Groner fails to anticipate, teach or suggest the embodiment of the invention claimed in independent claims 18 for at least the following reasons. Groner does not anticipate, teach or suggest: (1) obtaining a pre-existing document; or (2) obtaining verbalized comments comprising annotations to said document. Each of these distinctions is discussed in further detail below.

1. Groner does not anticipate, teach or suggest obtaining a pre-existing document. As a voicemail to email conversion system, Groner is concerned with the generation of a new voice message from which a new text message can be derived for transmission as email. The voice message and text message are created when the user calls the voicemail system. In contrast, the invention embodiment of independent claim 18 (as amended) obtains a pre-existing document from memory. Nothing in Groner teaches or suggests obtaining a pre-existing document, nor is there any motivation in the voicemail to email system of Groner to obtain a pre-existing document.

2. Groner does not anticipate, teach or suggest obtaining verbalized comments comprising annotations to said document. As discussed above with respect to independent claim 1, Groner does not teach or suggest annotating a document. Rather, Groner is concerned with editing the contents of a voice message. For this reason, Groner also does not obtain comments comprising annotations to a pre-existing document.

For at least the foregoing reasons, Applicant submits that independent claim 18 is allowable over the cited reference. Further, claims 19-31, being dependent upon allowable base claim 18, are also allowable for at least the foregoing reasons.

D. Independent Claim 32

With respect to independent claim 32, the Examiner states:

Groner discloses a method for annotating a document (see Figures 1-11; see Column 1, Line 1 through Column 24, Line 24), comprising:

- obtaining a document from a memory medium via an interconnection path configured to access said document, said document having text elements (as indicated in the above rejections for Claims 18 and 19, the messaging system discloses this limitation);
- obtaining a first annotation of said text document, said first annotation having a first set of audio elements (as indicated

in the above rejection for Claim 18, the messaging system discloses this limitation);

- converting said text elements to a second set of audio elements (as indicated in the above rejection for Claim 18, the messaging system discloses this limitation);
- associating said first set of audio elements with said second set of audio elements to generate a playback document (the messaging system discloses “associating said first set of audio elements with said second set of audio elements to generate a playback document” in that it includes the caller’s verbalized edits with the voice message and converts the edited voice message to text);
- generating an audible playback of said playback document to a user when said user indicates a desire to hear said document (the messaging system discloses “generating an audible playback of said playback document to a user when said user indicates a desire to hear said document” in that, after the caller incorporates the original edits into the voice message and the voice message is converted to text, it again asks whether the caller wants to edit the message; when the caller desires to edit the message again, the messaging system converts the edited text message to a voice message and plays it to the caller);
- obtaining verbalized comments from said user via an audio input mechanism upon activation of an annotation trigger during said audible playback (as indicated in the above rejection for Claim 18, the messaging system discloses this limitation);

- associating said verbalized comments with a location in said playback document corresponding with the occurrence of said annotation trigger during said audible playback (as indicated in the above rejection for Claim 18, the messaging system discloses this limitation).

Applicant respectfully disagrees. Applicant submits that Groner fails to anticipate, teach or suggest the embodiment of the invention claimed in independent claims 32 for at least the following reasons. Groner does not anticipate, teach or suggest: (1) obtaining a first annotation of the document from an annotations file; or (2) obtaining verbalized comments comprising a second annotation. Each of these distinctions is discussed in further detail below.

1. Groner does not anticipate, teach or suggest obtaining a first annotation of the document from an annotations file. As previously discussed, Groner does not provide annotation capability, let alone an annotations file. Groner obtains a voice message, which is converted to a text message. Groner then provides the user with an opportunity to change the voice/text message by voicing the desired changes. In contrast, the invention embodiment of independent claim 32 obtains a document and a first annotation of said document from an annotations file. Applicant submits that Groner does not teach or suggest the recited annotations file.

2. Groner does not anticipate, teach or suggest obtaining verbalized comments comprising a second annotation. As discussed above with respect to independent claims 1, 7 and 18, the system of Groner does not obtain annotations. The verbalized information in Groner is either the originally obtained voice message or a modified voice message. In contrast, independent claim 32 of the present application recites obtaining comments comprising an annotation.

For at least the foregoing reasons, Applicant submits that independent claim 32 is allowable over the cited reference. Further, claims 33-45, being dependent upon allowable base claim 32, are also allowable for at least the foregoing reasons.

E. Independent Claim 46

With respect to independent claim 46, the Examiner states:

Groner discloses a method for annotating a document (see Figures 1-11; see Column 1, Line 1 through Column 24, Line 24), comprising:

- generating authentication information of a user desiring access to a document (the messaging system discloses “generating authentication information of a user desiring access to a document” in that it determines whether the caller is a subscriber to the messaging system);

- allocating an associations file structure for said user (the messaging system discloses “allocating an associations file structure for said user” in that it generates a message header data structure to identify the caller);
- obtaining said document from a memory medium via an interconnection path configured to access said document, said document having text elements (as indicated in the above rejection for Claim 32, the messaging system discloses this limitation);
- obtaining a first annotation of said text document, said first annotation having a first set of audio elements (as indicated in the above rejection for Claim 32, the messaging system discloses this limitation);
- converting said text elements to a second set of audio elements (as indicated in the above rejection for Claim 32, the messaging system discloses this limitation);
- associating said first set of audio elements with said second set of audio elements to generate a playback document (as indicated in the above rejection for Claim 32, the messaging system discloses this limitation);
- generating an audible playback of said playback document to said user when said user indicates a desire to hear said document (as indicated in the above rejection for Claim 32, the messaging system discloses this limitation);
- obtaining verbalized comments from said user via an audio input mechanism upon activation of an annotation trigger during said audible playback (as indicated in the above

rejection for Claim 32, the messaging system discloses this limitation);

- associating said verbalized comments with a location in said playback document corresponding with the occurrence of said annotation trigger during said audible playback (as indicated in the above rejection for Claim 32, the messaging system discloses this limitation); and
- storing said location and said authentication information of said user and said verbalized comments in said associations file structure (the messaging system discloses “storing said location and said authentication information of said user and said verbalized comments in said associations file structure” in that it stores the message header data structure and the caller’s verbalized edits and incorporates them into the appropriate parts of the text message).

Applicant respectfully disagrees. Applicant submits that Groner fails to anticipate, teach or suggest the embodiment of the invention claimed in independent claims 46 for at least the following reasons. Groner does not anticipate, teach or suggest: (1) generating authentication information of a user desiring access to a pre-existing document; and (2) obtaining a first pre-existing annotation of said document; (3) associating said first set of audio elements (from a pre-existing annotation) with said second set of audio elements (from a pre-existing document) to generate a playback document; (4) obtaining verbalized comments comprising a second annotation of said document; and (5) storing said

location and said authentication information of said user and said verbalized comments in said associations file structure. Each of these distinctions is discussed in further detail below.

1. Groner does not anticipate, teach or suggest generating authentication information of a user desiring access to a pre-existing document. The Examiner indicates that the use of a password to access the voicemail system anticipates generating authentication information of a user desiring access to a document. Applicant submits that Groner does not contemplate a user desiring access to a "pre-existing" document, as recited in the invention embodiment of claim 46 (as amended). The invention embodiment of claim 46 is directed to the annotation of a document in memory, whereas Groner is directed to the creation of a voice message and optional revision of the just-created voice message. Because Groner does not anticipate a user desire access to a pre-existing document, Groner also does not generate authentication information of a user desiring access to a pre-existing document.

2. Groner does not anticipate, teach or suggest obtaining a first pre-existing annotation of said document. Whereas the invention embodiment of claim 46 (as amended) obtains a pre-existing annotation of the pre-existing document, Groner provides no annotation capability and therefore no access to

pre-existing annotations. Groner is only directed to processing of current voice messages.

3. Groner does not anticipate, teach or suggest associating said first set of audio elements (from a pre-existing annotation) with said second set of audio elements (from a pre-existing document) to generate a playback document.

Groner offers the capability of playing back a voice message; however, the voice message of Groner does not arise from audio elements related to a pre-existing document, or from such audio elements associated with further audio elements from a pre-existing annotation of the document. The revisions of Groner do not anticipate annotations.

4. Groner does not anticipate, teach or suggest obtaining verbalized comments comprising a second annotation of said document. As discussed above with respect to the other independent claims, Groner does not obtain annotations of a document.

5. Groner does not anticipate, teach or suggest storing said location and said authentication information of said user and said verbalized comments in said associations file structure. The Examiner has indicated that the email header of Groner anticipates the claimed associations file structure. Applicant disagrees. Further, Applicant submits that the email header of Groner does not include

verbalized comments that comprise annotations of a pre-existing document, nor does the email header comprise a location of the playback file associated with the verbalized comments.

For at least the foregoing reasons, Applicant submits that independent claim 46 is allowable over the cited reference. Further, claims 47-59, being dependent upon allowable base claim 46, are also allowable for at least the foregoing reasons.

III. Rejection of Claims Under 35 U.S.C. §103(a)

The Examiner has issued the following rejections under 35 U.S.C. §103(a): claims 30, 31, 44, 45, 58 and 59 are rejected as being unpatentable over Groner (U.S. Patent No. 6,507,643); claims 3, 21, 35 and 49 are rejected as being unpatentable over Groner, in view of Merrill et al. (U.S. Patent No. 6,181,351); and claims 4, 27, 41 and 55 are rejected as being unpatentable over Groner, in view of Gupta et al. (U.S. Patent Application Publication No. US 2003/0196164 A1). Applicant respectfully disagrees. Claims 3, 4, 21, 27, 30, 31, 35, 41, 44, 45, 49, 55, 58 and 59, being dependent upon respective allowable base claims, are also allowable for at least the foregoing reasons provided with respect to independent claims 1, 7, 18, 32 and 46.

Further, with respect to claims 30-31, 44-45 and 58-59, the Examiner states that the conversion of text to speech at the client is a mere design choice. Applicant respectfully disagrees. Groner is a voicemail to email conversion system, which a user may access by regular telephone. However, Applicant submits that such telephones are not equipped to perform text to audio conversion. It is therefore not a mere design choice to carry out text to speech conversion at the server with respect to the cited reference. The conversion of text to speech at a client (i.e., telephone) is beyond the scope of Groner. In contrast, the present application describes both thin client and smart client embodiments, with annotation devices having the processing power of a computer, for example. The invention is therefore specifically enabled for both types of embodiments, with the processing needs of each described in detail. In view of the foregoing, Applicant submits that the characterization of client processing of text to speech conversion as a mere design choice is a misstatement of the range of the prior art, specifically of Groner. Thus, claims 30-31, 44-45 and 58-59 are allowable over the cited reference for the additional reason that Groner does not and cannot implement text to speech conversion at the client.

Appl. No. 09/802,395  
Response Dated January 14, 2004  
Reply to Office Action Dated July 14, 2004

IV. Conclusion

For at least the foregoing reasons, Applicant submits that pending claims 1-59 are in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

THE HECKER LAW GROUP

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